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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,746	02/09/2000	Robert J Winchester	57005-B/JPW/JSC	3022

7590

09/11/2002

John P White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

SCHWADRON, RONALD B

ART UNIT PAPER NUMBER

1644

DATE MAILED: 09/11/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/500,746

Applicant(s)
Winchester et al.

Examiner
Ron Schwadron, Ph.D.

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 24, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) 1-6, 8-10, and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 11, 12, 16, and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

1. Applicant's election with traverse of Group II and the species bicyclam in Paper No. 11 is acknowledged. The traversal is on the ground(s) that are stated in said paper. This is not found persuasive because of the following reasons. Regarding applicants comments, the USPTO interprets independent and distinct as reading on independent or distinct (see M.P.E.P. 802.01 and 803). The MPEP section 803 states:

Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(I)) or distinct (MPEP § 806.05 - § 806.05(I)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(I)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(I), § 808.01(a), and § 808.02).

The Office Action mailed 12/18/2001, paragraphs 2-4 explains why inventions I-III are distinct. Regarding applicants comments about serious burden, the M.P.E.P. § 803 (July 1998) states that: "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search". The restriction requirement enunciated in the previous Office Action meets this criterion and therefore establishes that serious burden is placed on the Examiner with regards to searching other Groups. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6,13-15,8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected inventions or species, the requirement having been traversed in Paper No. 11.
3. Claims 7,11,12,16,17 are under consideration.
4. The abstract of the disclosure is objected to because according to 37 CFR 1.72 (as per post AIPA changes) the abstract needs to be no more than 150 words. Correction is required. See MPEP § 608.01(b).
5. Applicant needs to update the status of application 09/127651 disclosed in page 1 of the specification (eg. now abandoned).
6. Drawings and photographs have been submitted which fail to comply with 37 CFR 1.84 or 1.152 as per the enclosed PTO 948.
Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in ABANDONMENT of the application.
7. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claims 7,11,16,17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide adequate written description of the claimed invention. The legal standard for sufficiency of a patent's (or a specification's) written description is whether that description "reasonably conveys to the artisan that the inventor

had possession at that time of the . . . claimed subject matter", Vas-Cath, Inc. V. Mahurkar, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). In the instant case, the specification does not convey to the artisan that the applicant had possession at the time of invention of the claimed agents.

The instant claims recite an agent that is capable of Inhibiting the activation of CXC4 by SDF-1. Claims 7,16,17 read on any agent while claim 11 reads on any nonpeptidyl agent. The claims encompass a vast array of agents with undefined structure wherein the structure of said agents is not disclosed in the specification. The only nonpeptidyl agent disclosed in the specification is a bicyclam. The only other agents with the functional properties recited in the claims are antibodies or peptides based on the two molecules recited in the claims. Thus, the written description provided in the specification is not commensurate with the scope of the claimed inventions. In view of the aforementioned problems regarding description of the claimed invention, the specification does not provide an adequate written description of the invention claimed herein. See *The Regents of the University of California v. Eli Lilly and Company*, 43 USPQ2d 1398, 1404-7 (Fed. Cir. 1997). In *University of California v. Eli Lilly and Co.*, 39 U.S.P.Q.2d 1225 (Fed. Cir. 1995) the inventors claimed a genus of DNA species encoding insulin in different vertebrates or mammals, but had only described a single species of cDNA which encoded rat insulin. The court held that only the nucleic acids species described in the specification (i.e. nucleic acids encoding rat insulin) met the description requirement and that the inventors were not entitled to a claim encompassing a genus of nucleic acids encoding insulin from other vertebrates, mammals or humans, *id.* at 1240. In the instant case, the specification has disclosed a few specific agents with the functional property recited in the claims, while claiming any agent with the functional property recited in the claims. The Federal Circuit has held that if an inventor is "unable to envision the detailed constitution of a gene so as to distinguish it from other materials. . . conception has not been achieved until reduction to practice has occurred", *Amgen, Inc. v. Chugai Pharmaceutical Co, Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991). Attention is also directed to the decision of *The Regents of the University of California v. Eli Lilly and Company* (CAFC, July 1997) wherein is stated: The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention

achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material.

Thus, as we have previously held, a cDNA is not defined or described by the mere name "cDNA," even if accompanied by the name of the protein that it encodes, but requires a kind of specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the cDNA. See Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 7,11,12,16,17 are rejected under 35 U.S.C. 102(a) as being anticipated by Schols et al.

The recitation of an intended use carries no patentable weight in the instant product claims. The recitation of a method of making the claimed compound/composition carries no patentable weight in the instant product claims. Schols et al. teach a bicyclam (AMD3100) and said compound in a carrier/pharmaceutically acceptable carrier (eg. media used to dissolve said compound or PBS)(see page 147 and page 149, second column, first complete paragraph and Figure 2). Claim 12 defines bicyclam as a "nonpeptidyl agent".

11. Claims 7,11,12,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by De Vreese et al.

The recitation of an intended use carries no patentable weight in the instant product claims. The recitation of a method of making the claimed compound/composition carries no patentable weight in the instant product claims. De Vreese et al. teach the bicyclams JM3100 or JM2763 and said compound in a carrier/pharmaceutically acceptable carrier (eg. media used to dissolve said compound)(see page 210 and section 2.3). Claim 12

defines bicyclam as a "nonpeptidyl agent".

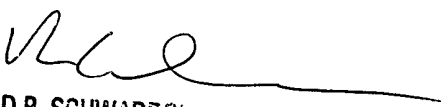
12. Claims 7,11,12,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Murrer et al. (US Patent 5,021,409)

The recitation of an intended use carries no patentable weight in the instant product claims. The recitation of a method of making the claimed compound/composition carries no patentable weight in the instant product claims. Murrer et al. teach bicyclams in a carrier/pharmaceutically acceptable carrier (see column 1, third paragraph, column 2, penultimate paragraph and claims 7 and 8). Claim 12 defines bicyclam as a "nonpeptidyl agent".

13. No claim is allowed.

14. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers should be faxed to Group 1600 at (703) 308-4242.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.


RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1600 (600)

Ron Schwadron, Ph.D.
Primary Examiner
Art Unit 1644